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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,894	10/23/2003	Mike E. Little	5681-33700	8981

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EXAMINER

WILSON, YOLANDA L

ART UNIT PAPER NUMBER

2113

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,894

Applicant(s)

LITTLE ET AL.

Examiner

Yolanda L. Wilson

Art Unit

2113

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/0504/05:07/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3,5-11,15-22,26-31,33-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobata et al. (USPN 6170065B1). As appears in claim 1, Kobata et al. discloses a processor; a memory coupled to the processor and configured to store program instructions executable by the processor to implement in Figure 1 and in column 3, lines 52-59: a knowledge automation engine in column 4, lines 23-27 comprising: a knowledge interface to receive one or more checks and one or more corresponding product check matrixes from a knowledge repository, wherein the one or more of packages and patches applicable to one or more product issues in column 4, lines 29-31; a fact interface to receive one or more facts describing a product configuration in column 4, lines 23-27; wherein the knowledge automation engine automatically evaluates a rule in the one or more checks against the one or more facts to determine if the one or more product issues specified by the one or more checks exists for the product configuration in column 2, lines 28-39; and wherein if the one or more product issues are detected, the knowledge automation engine applies one or

Art Unit: 2113

more of packages and patches in the one or more corresponding product check matrixes to correct the one or more product issues in column 2, lines 28-39 and in column 4, line 45 – column 5, line 5. Product check matrixes is the database that comprises configuration information of the system software and hardware.

3. As per claim 2, Kobata et al. discloses wherein the one or more product check matrixes comprises: a package and a patch associated with the package in column 2, lines 35-39. The package is the name of the problem software or hardware. The patch is the solution.

4. As per claim 3, Kobata et al. discloses wherein the association between the package and the patch is predefined in column 2, lines 35-39.

5.

6. As per claim 5, Kobata et al. discloses wherein the one or more product check matrixes are stored on a database accessible by the knowledge automation engine in column 4, lines 35-39.

7. As per claim 6, Kobata et al. discloses wherein the one or more packages identified in one or more product check matrixes are stored in a separate database than the one or more product check matrixes in column 4, lines 32-35.

8. As per claims 7,18,29,36, Kobata et al. discloses listing one or more packages in a product check matrix, wherein the one or more packages are related to a product issue; and defining one or more check elements related to the product issue, wherein the one or more check elements includes a rule, wherein the rule may be evaluated

against a fact to determine if a product issue is present on a product in column 4, lines 23-37 and in column 4, line 45 – column 5, line 5.

9. As per claims 8,19,30,37, Kobata et al. discloses retrieving a fact from a fact repository about the product in column 4, lines 23-27.

10. As per claims 9,20,31,38, Kobata et al. discloses evaluating the rule to detect one or more product issues in column 2, lines 28-39 and in column 4, line 45 – column 5, line 5.

11. As per claims 10,21,39, Kobata et al. discloses wherein if one or more product issues are detected, one or more packages from the product check matrix are applied in column 2, lines 28-39 and in column 4, line 45 – column 5, line 5.

12. As per claims 11,22, Kobata et al. discloses defining one or more associations between a package in the product check matrix and one or more patches in column 2, lines 28-39 and in column 4, lines 23-37.

13. As per claims 15,26,33,40, Kobata et al. discloses wherein one or more check elements are defined in a separate check in column 2, lines 28-39 and in column 4, line 45 – column 5, line 5.

14. As per claims 16,27,34,41, Kobata et al. discloses wherein the one or more check elements are defined with the product check matrix and are used with the product check matrix in column 2, lines 28-39 and in column 4, line 45 – column 5, line 5.

15. As per claims 17,28,35,42, Kobata et al. discloses wherein the one or more check elements are selected from a group consisting of a check rule, a problem

Art Unit: 2113

statement, and reference documentation in column 2, lines 28-39 and in column 4, line 45 – column 5, line 5 and in column 4, lines 23-37.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4,12,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata et al. in view of Chamberlain et al. (USPN 6434744B1).

18. As per claim 4, Kobata et al. discloses wherein if the patch associated with the package is updated with a new patch in a database accessible by the knowledge automation engine, the association with the package is updated with the new patch.

Chamberlain et al. discloses this limitation in column 5, lines 10-19.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have wherein if the patch associated with the package is updated with a new patch in a database accessible by the knowledge automation engine, the association with the package is updated with the new patch. A person of ordinary skill in the art would have been motivated to have wherein if the patch associated with the package is updated with a new patch in a database accessible by the knowledge automation engine, the association with the package is updated with the new patch because the new patches are under new packages.

19. As per claims 12,23, Kobata et al. discloses wherein if one or more patches corresponding to the one or more associations are updated, the one or more associations are updated with the one or more patches.

Chamberlain et al. discloses this limitation in column 5, lines 10-19.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have wherein if one or more patches corresponding to the one or more associations are updated, the one or more associations are updated with the one or more patches. A person of ordinary skill in the art would have been motivated to have wherein if one or more patches corresponding to the one or more associations are updated, the one or more associations are updated with the one or more patches because the new patches are under new packages.

20. Claims 13,14,24,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata et al. in view of Benayoun et al. (USPN 6510552B1).

21. As per claims 13,24, Kobata et al. discloses defining one or more associations between a package in the product check matrix and one or more patches, accessible by a knowledge automation engine in column 4, lines 23-39; column 4, line 45 – column 5, line 5.

Benayoun et al. discloses this limitation in column 2, lines 52-57.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have wherein the one or more associations are defined according to patch updates applied to the one or more packages in a database. A person of ordinary skill in the art would have been motivated to have wherein the one or

Art Unit: 2113

more associations are defined according to patch updates applied to the one or more packages in a database because the patches are under different file names for the packages they are associated with.

22. As per claims 14,25, Kobata et al. discloses fails to explicitly state disassociating one or more associations formed between a package and one or more patches if one or more patches are replaced.

Benayoun et al. discloses this limitation in column 2, lines 52-57.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have disassociating one or more associations formed between a package and one or more patches if one or more patches are replaced. A person of ordinary skill in the art would have been motivated to have disassociating one or more associations formed between a package and one or more patches if one or more patches are replaced because the patches are under different file names.

Double Patenting

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 2113

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.

10/318707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the product check matrixes are the facts describing a product configuration associated with the patches and packages used to correct the product issues that represent the remediation information disclosed in claim 1 of '707; therefore, it would be obvious to have the product check matrixes in '707 because of this rationale.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

25. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

26. Claims 18-28,36-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 18-28,36-42 contain the limitations 'A carrier medium...' This limitation states a program per se. Also, these claims are directed to non-statutory subject matter by way of the specification. The first paragraph on page 40 of the specification states the computer readable medium can be 'transmission media or signals such as electrical, electromagnetic or digital signals...'

Art Unit: 2113

This is non-statutory subject matter. A possible correction is 'A computer readable storage medium comprising computer readable instructions stored thereon to be executed on a processor, the instructions comprise...'

Claim Objections

27. Claims 29-32,33-35 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 7-10,15-17. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

28. Claims 36-39,40-42 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 18-21,26-28. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

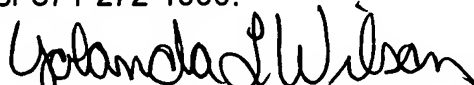
29. Claims 21,23,39 are objected to because of the following informalities: These claims recite 'The method'. They should recite 'The carrier medium'. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yolanda L. Wilson whose telephone number is (571) 272-3653. The examiner can normally be reached on M-F (7:30-4:00).

Art Unit: 2113

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yolanda L Wilson
Examiner
Art Unit 2113